

Appl. No. 09/489,310
Docket No. 7922
Appeal Brief dated 7/31/2006
Reply to Office Action mailed on 3/29/2006
Customer No. 27752

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P&G Case 7922

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of :
GARY (NMN) STEPHENSON : Confirmation No. 5677
Serial No. 09/489,310 : Group Art Unit 1614
Filed January 21, 2000 : Examiner: Frederick F. Krass
For METHODS OF USING A BEVERAGE COMPOSITION

APPELLANT'S BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant hereby appeals to the Board of Appeals the decision of the Examiner dated January 9, 2003, finally rejecting Claims 23-31. The Notice of Appeal was timely filed and received in the US Patent and Trademark Office on March 29, 2006. The four-month anniversary of the receipt of the Notice of Appeal fell on Saturday, July 29, 2006, and this Brief is filed on Monday, July 31, 2006. As such, a request for a two month extension of time to file this Brief is requested.

REAL PARTY IN INTEREST

The real party in interest is The Procter & Gamble Company, assignee of Appellant's entire right, title, and interest in the invention at issue. The Assignment to the Procter & Gamble Company for this case is recorded at the Patent and Trademark Office at Reel 013571 and Frame 0346.

RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's undersigned legal representative and the Assignee are not aware of any pending appeals or interferences that would be directly affected by or have a bearing on the Board's decision in the subject Appeal.

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STATUS OF CLAIMS

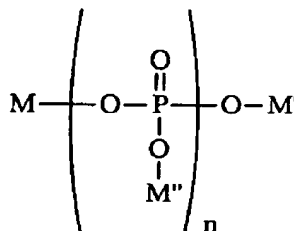
Claims 23-31 are the subject of this appeal. No other claims are pending or allowed. Claims 1-22 were cancelled during prosecution. Claims 23-31 were finally rejected in the Final Office Action dated December 29, 2005. The claims on appeal are set forth in Appendix I.

STATUS OF AMENDMENTS

No amendments were filed or proposed after the Final Office Action in this case. And it is believed that all previous amendments have been entered and considered.

SUMMARY OF THE INVENTION

The present invention is related to a method of treating dental erosion comprising orally administering to a mammal a beverage composition that has a pH of less than about 5. [Spec. Page 3, Lines 6-7] and is substantially free of calcium and fluoride [Spec. Claim 21]. Further the beverage composition comprises a compound having the structure:



In the formula above, n is an integer averaging from about 7 to about 100 and M, M', and M'' are each, independently, selected from the group consisting of sodium and potassium. [Spec. Page 3, Lines 10-11]

Dental erosion involves the softening of dental enamel and eventual loss of enamel due to the softening. [Spec. Page 4, Lines 10-11] Low pH beverages are a common cause of dental erosion because tooth enamel degrades substantially more quickly in a low pH environment. [Spec. Page 4, Lines 11-12] As such, providing a beverage composition with low pH that wards off the erosion caused by that same beverage, is a desirable proposition. [Spec. Page 2, Lines 31-33]

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GROUND FOR REJECTION TO BE APPEALED

There is only one rejection of the present claims, which in the subject of this appeal. Claims 23-31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 3,681,091, to Kohl et al.

ARGUMENTS

A. The Examiner's Rejection Under 35 U.S.C. § 102(b)

The Examiner has rejected Claims 23-31 under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 3,681,091, to Kohl et al

B. The Prior Art

In the Office Action dated November 1, 2004, the Examiner stated with regard to the method claims being prosecuted:

“---a method of treating dental erosion comprising orally administering to a mammal in need thereof an effective amount of a beverage composition...---

Were this language to be adopted, claims 23-31 would be allowable.” Underline added to highlight the added language. See, Page 3 of the Office Action.

This same suggestion is made in the previous Office Action dated March 17, 2004. See page 4, first full paragraph. In both Office Actions, the Examiner states that the method claims would be distinguished over Kohl with the addition of the “in need thereof” is amendment. The Examiner based this recommended claim amendment on the CAFC decision in *Jansen v. Rexall*, 342 F.3d 1329 (Fed. Cir. 2003).

In direct response to the Examiner's suggestions the Appellant made the suggested amendment. In a gratuitous explanation for the Amendment, the Appellant mentioned that liquids are an essential part of everyone's diet. And therefore, everyone is in need of beverages.

The Examiner now asserts that these statements made during prosecution obviate the amendments. And the Examiner now requires much more restrictive language in the claims. The additional amendments proposed by the Examiner are not supported by any

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proper interpretation of the *Jansen* case. The case does not require that additional language be added to the claims, beyond that which has been added to the present claim, namely "in need thereof".

The *Jansen* case does not require, as the Examiner suggests that the person using the presently claimed beverage be instructed to do so by, for example, a doctor. The *Jansen* decision merely requires that the "need be appreciated". In the present case, it is notoriously well known that acidic beverages, which include most colas, fruit flavored and fruit based beverages, slowly erode tooth enamel. As such, the average consumer of a cola product appreciates the need for enamel erosion control.

Moreover, the *Jansen* case deals with scope of enforceability rather than patentability of the claims. The present claims, like the claims in *Jansen* are patentable, but the *Jansen* decision sets forth limits on how the claims can be infringed. In *Jansen* a competitive product, which fell within the literal scope of the composition claimed, did not infringe because the alleged infringing product did not recommend taking the vitamin supplement to combat the form of anemia claimed. As such, there was no direct infringement by the consumer, because there was no proof they were taking the supplements to combat their anemia.

It is understood that when the present claims issue, their enforcement will not extend to the beverages themselves¹ but rather to the methods of using the beverages. And the claims will extend only to methods of use for controlling dental erosion. For example, if beverage compositions that fall within the scope of these claims are sold and marketed for rehydration, with no mention on the package, in advertising, or in other communications to the consumer of the dental erosion benefits, then these beverages will arguably not be covered under the present claims.

¹ The Real Party at Interest, The Procter & Gamble Company, has a variety of patents on the beverages themselves which have been cited and considered in the present application. As such, the Appellant makes no assertion that the present claims are directed to the beverages *per se*.

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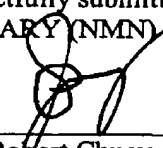
As such, the claims in the present case are patentable over Kohl as the Examiner has stated in two different Office Actions. Accordingly, the Appellant respectfully requests that the present rejection be overturned and the claims be allowed.

CONCLUSION

It is respectfully submitted that the Examiner's rejection of Claims 23-31 under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 3,681,091, to Kohl et al. should be overturned. For all of the foregoing reasons, it is respectfully asserted that the methods of the present claims patentable over the prior art. Reversal of this rejection is therefore respectfully requested.

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Respectfully submitted,
For: GARY (NMN) STEPHENSON

By 
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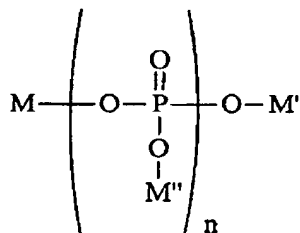
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APPENDIX I
Appealed Claims

23. A method of treating dental erosion comprising orally administering to a mammal in need thereof an effective amount of a beverage composition having a pH of less than about 5;

wherein the beverage composition comprises a compound having the structure:



wherein n is an integer averaging from about 7 to about 100 and M, M', and M'' are each, independently, selected from the group consisting of sodium and potassium, and wherein the beverage composition is substantially free of calcium and fluoride.

24. A method according to Claim 23 wherein the beverage composition has a pH from about 2 to about 4.5.
25. A method according to Claim 24 wherein the beverage composition further comprises a sweetener.
26. A method according to Claim 25 wherein M, M', and M'' are each sodium.
27. A method according to Claim 26 wherein n is an integer averaging from about 10 to about 30.

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28. A method according to Claim 27 wherein the beverage composition has a pH from about 2.7 to about 3.5.
29. A method according to Claim 28 wherein n is an integer averaging from about 13 to about 25.
30. A method according to Claim 29 wherein the beverage composition comprises from about 0.1% to about 20% of the sweetener, by weight of the composition.
31. A method according to Claim 30 wherein n is an integer averaging from about 19 to about 25.

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CLAIMS APPENDIX

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EVIDENCE APPENDIX